UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	9

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No	Applicant(s)
09/442,256	YIGZAW
Examiner	**Group Art Unit**
DR. HERBERT J. LILLING	1651

X Responsive to communication(s) filed on *Jul 26, 2000*

This action is **FINAL.**

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *THREE* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

X Claim(s) *2-53* is/are pending in the applicat

Of the above, claim(s) *2-21, 23-27, 32-35, 37, and 41-53* is/are withdrawn from considcration

Claim(s) _____ is/are allowed.

X Claim(s) *22, 28-31, 36, and 38-40* is/are rejected.

Claim(s) _____ is/are objected to.

X Claims *2-53* are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

X Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Receipt is acknowledged of the election filed July 26, 2000.

2. Claims 2-53 remain present in the instant application.

Claim 1 was previously cancelled.

3. Applicant has elected with traverse, II, Claims 22-40, drawn to a method of producing a composition of extracts of plant material, classified in class 424, subclass 195.1.

Claims 2-21, 41-53, and species 23-27 + 32-35 and 37 have withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8 dated July 26, 2000.

The restriction as well as the election requirements are proper as stated in the previous Office action. The arguments have been deemed not to be persuasive to withdraw the requirements. The withdrawn inventions, I ,Claims 2-21, drawn to a composition, classified class 424, subclass 195.1 and III Claims 41-53, drawn to a method of treating , classified in class 424, subclass 195.1 have been considered to be separate and patentably distinct as indicated in the previous Office action whereby the inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process e.g. extracts of other plants or by organic synthetic methods and

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case , the product as claimed can be used in a materially different process of using that product e.g. treating patients for lowering cholesterol or controlling triglycerides--which Applicant alleges cannot be possible since the extracts cannot only be prepared by the disclosed species. This argument is essentially totally incorrect since it is well known that extracts of plants can produce various ingredients, each one of which is an extract and various plants can produce the same ingredients. The argument that an additional search of the various species is not an undue burden is again incorrect especially if the broad claim is found not to be allowable, then no further search and examination would have to take place in accordance with compact prosecution. Applicant have claimed exceptionally broad language which has required the above restriction and election in order to be within the guidelines of the

Office policy of compact prosecution. Upon the allowance of any generic claim, any additional steps or reagents would be considered to be rejoined with the elected invention.

The restriction has been made FINAL with the proviso that any further steps or reagents would be considered within the scope of the allowable broad claim(s).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 38-39 and 40 are rejected under 35 U.S.C. 102(b) as anticipated by Ageel et al BIOS ABSTRACT BA89:92285 which disclosure teaches the organic extraction of one of the claimed plant species whereby the extract is dried and then dissolved in water which anticipates the claimed inventions

or, in the alternative,

Claims 22 and 28-31, 36, 38-40 are rejected under 35 U.S.C. 103(a) as obvious over Ageel et al BIOS ABSTRACT BA89:92285, Kavimani et al CABA ABSTRACT 2000:53058 or Shah et al SCISEARCH ABSTRACT 91:548657.

Each of the references teaches the extraction of a plant material with a solvent that is within the scope of the claimed process. The references do not disclose an additional solvent extraction which is considered to be prima facie obvious to one of ordinary skill in the art to

maximize the separation of the desired product as well as to increase the yield from the crude plant material absent unexpected or unobvious process steps or unexpected properties due to the second process step for the increased yield of the product.

5. **No claim is allowed.**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is (703) 308-2034 and fax number (Art Unit 1651) is (703) 305-7939 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL
(703) 308-2034
Art Unit 1651
August 09, 2000

HERBERT J. LILLING
PATENT EXAMINER
GROUP 1600 ART UNIT 1651